

**REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-12 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, claims 1 and 6 have been amended to more clearly recite the features of the present invention. New claims 9-12 are supported by the Specification at, for example, page 14, line 21 to page 17, line 12. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

**Issues Under 35 U.S.C. § 102(b)**

The Examiner maintains the rejection of claims 1 and 3-4 under 35 U.S.C. §102 (b) as being anticipated by Ducker et al. (U.S. 5,938,649) (hereinafter Ducker '649). Applicants respectfully traverse.

The Examiner asserts that Ducker '649 discloses a diaper comprising a liquid impermeable back outer layer sheet, an absorber fixed on the outer layer sheet and a gather portion having a flexible elastic member formed on a predetermined position. The Examiner further asserts that Ducker '649 teaches the application of a water-soluble skin care agent on a surface to be contacted with the skin of the wearer and an oily skin care agent "applied directly on the water-soluble skin care agent".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. §102, the reference must teach each and

every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present". *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The present invention is directed, *inter alia*, to an absorbent article wherein a water-soluble skin care agent and an oily skin care agent are applied on a surface of the article. In the absorbent article of the present invention, the oily skin care agent is applied on a predetermined region of a sheet of absorbent article on which a water-soluble skin care agent is applied. The water-soluble skin care agent is applied on the whole surface to be contacted with the skin of the wearer of the gather portion. Further, the oily skin care agent is applied directly on the water-soluble skin care agent (without the need for auxiliary agents), so that at least a portion of the oily skin care agent is transferred to the skin of the wearer before the water-soluble skin care agent is transferred.

Contrary to the Examiner's assertion, Ducker '649 fails to implicitly or explicitly teach an absorbent article as presently claimed, wherein an oily skin care agent is applied directly on the water-soluble skin care agent, such that at least a part of the oily skin care agent is able to be transferred to the skin of a wearer before the water-soluble skin care agent transferred thereto.

At col. 5, lines 37-42, Ducker '649 discloses the following:

*"In this embodiment in which aloe vera is used in combination with a lubricant, particularly preferred solutions comprise from about 0.05 to 20 g of aloe vera per 1000 g of lubricant. Particularly preferred are concentrations of aloe vera from about 1 to 3 g per 1000 g of lubricant."*

At col. 7, lines 8-11, Ducker '649 further discloses:

*"...aloe vera in water based solutions is prone to spoilage...spoilage concerns are alleviated by placing the aloe vera in a relatively waterless lubricant. Preferably, the lubricant is petrolatum...the aloe vera and lubricant are mixed in a relatively uniform solution."* (emphasis added)

Clearly, Ducker '649 discloses that the oily skin care agent and the water-soluble skin care agent are mixed or blended together. Thus, Ducker '649 cannot possibly disclose an absorbent article wherein a water-soluble skin care agent is applied on the whole surface to be contacted with the skin of a wearer of the gather portion and an oily skin care agent is applied **directly on the water-soluble skin care agent** (emphasis added).

Evidently, Ducker '649 does not implicitly or explicitly disclose an absorbent article as claimed.

Thus, reconsideration and withdrawal of this rejection are respectfully requested.

**Issues Under 35 U.S.C. §103(a)**

The Examiner maintains the rejection of claim 2 under 35 U.S.C. §103(a) as being obvious over Ducker '649. Additionally, the Examiner maintains the rejection of claims 5-9 under 35 U.S.C. §103(a) as being obvious over Ducker '649 in view of Hoshino et al. (U.S.

6,685,953) (hereinafter Hoshino '953) further in view of Ptchelintsev et al. (U.S. 5,834,513) (hereinafter Ptchelintsev '513). Applicants respectfully traverse.

The Examiner asserts that the difference between Ducker '649 and the present invention is "the provision that the diamide formula is specifically as claimed". The Examiner relies on Hoshino '953 and Ptchelintsev '513 to overcome this deficiency.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

As noted above, Ducker '649 fails to teach an absorbent article wherein a water-soluble skin care agent is applied on the whole surface to be contacted with the skin of a wearer of the

gather portion and an oily skin care agent is applied directly on the water-soluble skin care agent. The secondary references cited by the Examiner fail to cure these deficiencies.

Hoshino '953 is directed to external preparation compositions comprising a diamide derivative. Hoshino '953 does not disclose the addition of this derivative to absorbent articles, or the combination of this composition with a water-soluble skin care agent.

Ptchelintsev '513 is directed to compounds used for treating skin conditions. Ptchelintsev '513 does not disclose the addition of these compounds to absorbent articles, or the combination of these compounds with a water-soluble skin care agent.

As discussed in the present Specification, the novel structure of the present absorbent article includes a layer formed by the water soluble skin care agent and the oily skin care agent. These agents are applied on the absorbent article separately and in a specific order.

As noted above, in the absorbent article of Ducker '649, the aloe vera (water soluble skin care agent) is dispersed in a lubricant (oily skin care agent). Thus, the lubricant is contacted with the surface of the gather portion. In contrast, in the present invention, the oily skin care agent is not contacted with the surface of the gather portion because the water soluble skin care agent is applied on the whole surface of the gather portion.

Moreover, as is known in the art, it is difficult to mix water soluble skin care agents and oily skin care agents without a surfactant, emulsifying agent and/or shear force. Thus, Applicants submit that one skilled in the art would not have been motivated to modify the absorbent article of Ducker '649 as proposed by the Examiner.

Furthermore, as discussed in the Response to Office Action filed on February 25, 2008 and the Supplemental Response to Office Action filed on April 10, 2008, the present absorbent article exhibits superior and unexpected characteristics over the article of Ducker '649.

The Examiner's attention is directed to the comparative testing in the Rule 132 Declaration of April 10, 2008, wherein an absorbent article corresponding to Ducker '649 was tested (Comparative Example 1). As can be seen, the present invention (Example 1) unexpectedly achieves a better and lower rate of diaper rash (reduction of incidences of more than half) versus Comparative Example 1. Further, a higher incidence of 1 out of 5 babies experienced rash when using the comparative absorbent article. Thus, this *Graham* factor weighs in Applicants' favor and the Rule 132 Declaration sufficiently rebuts the Examiner's rejection.

In the Office Action of June 27, 2008, the Examiner asserts that the Declaration filed on April 10, 2008 is insufficient to overcome the rejection of claims 1-9 based upon Ducker in view of Hoshino in view of Ptchelintsev, because "the facts are not germane to the rejection at issue". The Examiner asserts that the declaration "provides statements that the article of Ducker is not as effective as the claimed invention however, the claims are not directed to, for example, a method of effectively reducing diaper rash. The claims are directed to an absorbent article including specific compounds...". Applicants respectfully and strongly disagree.

According to MPEP 2112.01:

*"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.*

*Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 562 F.2d at 1255, 195 USPQ at 433. See also Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)."* (emphasis added)

Applicants submit that, although the present claims are directed to an absorbent article and not a method of controlling diaper rash, the evidence in the Declaration of April 10, 2008 rebuts the Examiner's *prima facie* case by showing that the prior art product (the absorbent article of Ducker '649) does not exhibit the characteristics (diaper rash prevention efficacy) of the claimed product.

Clearly, the present invention is not rendered obvious by Ducker '649, alone or in combination with the secondary references cited by the Examiner.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at

the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: September 29, 2008

Respectfully submitted,

for By  Reg # 61,158  
John W. Bailey  
Registration No.: 32,881  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant